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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,106	10/23/2003	Jodie L. Reynolds	60316/3	6565

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EXAMINER	
WONG, ALLEN C	

ART UNIT	PAPER NUMBER
2621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/692,106	REYNOLDS ET AL.	
	Examiner	Art Unit	
	Allen Wong	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25,27,28,31-55,57,58,61,62 and 64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *57* is/are allowed.

6)☒ Claim(s) *1-25,27,28,31-54,58,61,62 and 64* is/are rejected.

7)☒ Claim(s) *55* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/28/08 have been fully read and considered but they are not persuasive.

Regarding the 101 rejection, claims 1-25, 27, 28, 61 and 64 are now rejected under 101 because they are not tied to one of the four statutory categories of invention. Supreme Court precedent[1] and recent Federal Circuit decisions[2] indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process.

In regards to the double patenting rejection on 1-24, 28, 31-54, 58 and 61-63, the applicant stated that a terminal disclaimer was submitted. However, according to the PTO records, a terminal disclaimer has not been received by the Patent Office. Until applicant formally submits a terminal disclaimer to the Office, the double patenting rejection will be maintained.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

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[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[2] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-25, 27, 28, 61 and 64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent[3] and recent Federal Circuit decisions[4] indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example, claim 1, the media compression method including steps of "obtaining", "identifying", "automatically selecting", "compressing" and "delivering" is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of "obtaining", "identifying", "automatically selecting", "compressing" and "delivering" to limit the steps to the electronic form of the "method" and the claim language itself is sufficiently broad to read on a printout.

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[3] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[4] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Similarly, claim 27, the media compression method includes the steps of "providing", "obtaining", "identifying", "automatically selecting", "compressing" and "delivering" is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of "providing", "obtaining", "identifying", "automatically selecting", "compressing" and "delivering" to limit the steps to the electronic form of the "method" and the claim language itself is sufficiently broad to read on a printout.

Similarly, claim 28, the media compression method includes the steps of "selectively compressing" and "delivering" is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of "selectively compressing" and "delivering" to limit the steps to the electronic form of the "method" and the claim language itself is sufficiently broad to read on a printout.

Similarly, claim 64, the media compression method includes the steps of "obtaining", "identifying", "automatically selecting", "compressing", "delivering", "receiving", "decompressing" and "presenting" is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of "obtaining", "identifying", "automatically selecting", "compressing", "delivering", "receiving", "decompressing" and "presenting" to limit

the steps to the electronic form of the "method" and the claim language itself is sufficiently broad to read on a printout.

Similarly, claim 61, the computer readable medium includes "program code for obtaining", "program code for identifying", "program code for automatically selecting", "program code for compressing" and "program code for delivering" is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of "program code for obtaining", "program code for identifying", "program code for automatically selecting", "program code for compressing" and "program code for delivering" to limit the steps to the electronic form of the "method" and the claim language itself is sufficiently broad to read on a printout.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 61 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 61 contains subject new matter "computer readable medium encoded with computer executable instructions" or "computer program product" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention. See MPEP 706.03 (c).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24, 28, 31-54, 58 and 61-62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,295,608.

Claims 1, 31 and 62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,295,608. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application

is generic to all that is recited in claim 1 of US Patent No. 7,295,608. Claims 1, 31 and 62 of the instant application discloses "obtaining a media signal to be communicated to a destination system", "…a plurality of scenes within the media signal", "automatically selecting different codecs from a codec library to respectively compress at least two of the scenes, wherein the codecs are automatically selected to produce a highest compression quality for the respective scenes according to a set of criteria without exceeding a target data rate", "compressing the scenes using the automatically selected codecs", and "delivering the compressed scenes to the destination system with an indication of which codec was used to compress each scene". Claim 1 of U.S. Patent No. 7,295,608 discloses "obtaining a media signal to be communicated to a destination agent", "the media signal being separated into a plurality of segments…", "automatically selecting the CODEC that produces the highest quality encoded output for the segment according to a set of criteria without exceeding a bandwidth constraint", "wherein at least two segments are encoded using different CODECs", and "delivering the segment encoded using the selected CODEC to the destination agent… reporting to the destination agent which CODEC was used to encode the segment". In the U.S. Patent No. 7,295,608, the term "segment" is synonymous with "scene", and the term "destination agent" is synonymous with "destination system", and the term "without exceeding a bandwidth constraint" is very similar to "without exceeding a target data rate" since video bandwidth is related with target data rates. That is, claims 1, 31 and 62 is anticipated by claim 1 of US Patent No. 7,295,608.

Claim 2 and 32 of the instant application is similar to claim 10 of US Patent No. 7,295,608. Claim 3 and 33 of the instant application is similar to claim 10 of US Patent No. 7,295,608. Claim 4 and 34 of the instant application is similar to claim 10 of US Patent No. 7,295,608. Claim 5 and 35 of the instant application is similar to claim 3 of US Patent No. 7,295,608. Claim 6 and 36 of the instant application is similar to claim 6 of US Patent No. 7,295,608, wherein temporal characteristics pertain to motion characteristics and spatial characteristics pertain to color characteristics. Claim 7 and 37 of the instant application is similar to claim 4 of US Patent No. 7,295,608. Claims 8-9 and 38-39 of the instant application is similar to claim 5 of US Patent No. 7,295,608. Claim 10 and 40 of the instant application is similar to claim 1 of US Patent No. 7,295,608. Claim 11 and 41 of the instant application is similar to claim 7 of US Patent No. 7,295,608. Claims 12-13 and 42-43 of the instant application is similar to claim 8 of US Patent No. 7,295,608. Claim 14 and 44 of the instant application is similar to claim 3 of US Patent No. 7,295,608. Claim 15-17 and 45-47 of the instant application is similar to claim 9 of US Patent No. 7,295,608, in that bandwidth constraints are adjusted by changing the data target rate. Claim 18 and 48 of the instant application is similar to claim 3 of US Patent No. 7,295,608. Claim 19 and 49 of the instant application is similar to claim 1 of US Patent No. 7,295,608. Claim 20 and 50 of the instant application is similar to claim 3 of US Patent No. 7,295,608. Claim 21 and 51 of the instant application discloses “scene change” is detected is similar to claim 2 of US Patent No. 7,295,608, in that the “association between one or more identified characteristics

of the segment (ie.scene)" is made or the scene change associating the scene is made. Claim 22 and 52 of the instant application discloses is similar to claim 2 of US Patent No. 7,295,608, in that "scene change" is detected and the "association between one or more identified characteristics of the segment (ie.scene)" is made or the scene change associating the scene is made. Claim 23 and 53 of the instant application is similar to claim 11 of US Patent No. 7,295,608. Claim 24 and 54 of the instant application is similar to claim 12 of US Patent No. 7,295,608. Claims 28 and 58 of the instant application is similar to claim 1 of US Patent No. 7,295,608. That is, claims 28 and 58 is anticipated by claim 1 of US Patent No. 7,295,608, as similarly explained above for claims 1 and 31 of the instant application. Also, claim 61 of the instant application is similar to claim 1 of US Patent No. 7,295,608, in that claim 61 requires a computer readable medium.

Claim 64 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,295,608 in view of Puri (6,968,006).

Claim 64 of the instant application is similar to claim 1 of US Patent No. 7,295,608. Patent '608 does not disclose decompressing each compressed scene with the indicated codec, and presenting the decompressed scenes to a user. However, it would have been obvious to one of ordinary skilled to acknowledge that the Patent '608 does report data and the corresponding codec to the receiving terminal for display, otherwise compression of data would be obsolete if there was no decompressor (ie. decoder) to undo the compression process for permitting the user to view video data. Puri teaches the well known

concept of decompressing data (fig.16b, element 1714 and 1716, col.20, ln.39-40 and 57-62, note decompression of data is done), and presenting the decompressed scenes to a user of the destination system (fig.16b, element 1730, col.21, ln.15, user views the data decompressed). Thus, it would have been obvious to combine Puri's well known teaching of a decoder to decompress data with Patent '608 for permitting the high quality display of video data at the output for viewing at the user's end, while robustly minimizing the requirements of encoding and decoding circuitry (Puri col.3, ln.39-45).

Allowable Subject Matter

1. Claim 55 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

2. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not specifically disclose wherein at least one codec in the library has an associated licensing cost, and wherein selecting further comprises automatically selecting the codec having the least licensing cost in response to two or more codecs producing substantially the same quality of compressed output for a scene.

Claim 57 is allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not specifically disclose claim 27: a media compression system comprising: a library of codecs, at least one codec having

an associated licensing cost; an input module to obtain a media signal to be communicated to a destination system; an identification module to identify a plurality of scenes within the media signal; a selection module to automatically select different codecs from the codec library to respectively compress at least two of the scenes, wherein the codecs are automatically selected to produce a highest compression quality at the lowest licensing cost for the respective scenes according to a set of criteria without exceeding a target data rate; a compression module to compress the scenes using the automatically selected codecs; and an output module to deliver the compressed scenes to the destination system with an indication of which codec was used to compress each scene.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Wong whose telephone number is (571) 272-7341. The examiner can normally be reached on Mondays to Thursdays from 8am-6pm Flextime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2/4/09